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In re application of:

Frederick M. Abbas

Group Art Unit: 3752

Examiner: Davis D. Hwu

Serial No.: 09/941,377

Filed: August 28, 2001

For: SCENTED FOAM STRING FOR HUNTING

Attorney Docket No.: ABF 0104 PUS

REPLY BRIEF TO EXAMINER'S ANSWER  
UNDER 37 C.F.R. § 1.193(b)

Commissioner for Patents  
U.S. Patent and Trademark Office  
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Sir:

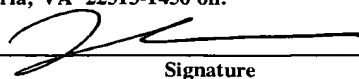
In response to the Examiner's Answer mailed July 20, 2004, the Appellants present the remarks below.

**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8**

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### Remarks

These remarks address the Examiner's comments in the Examiner's Answer mailed July 20, 2004.

With respect to **Paragraph (7), Grouping of Claims**, the Appellants respectfully submit that sufficient reason was set forth in the Appellant's Appeal Brief to support the that claims 3-6, 12-14, and 16-20 stand or fall together (Group 1) and claims 1, 2, and 11 stand or fall together (Group 2) with respect to Issue 1. Group 1 is patentability distinct from Group 2 in that Group 2 relates to a method of preventing contamination of an area around a target, as opposed to Group 1, which relates to an apparatus for dispensing a foam string scented with hunting scents. Group 1 is patentable distinct from Group 2 because it includes limitations directed towards recognizing the problem of contaminating an area around a target and Group 2 does not. The Appellants have provided, in the Appeal Brief, a convincing line of argument regarding the failure of the cited references to recognize this problem. Thus, Group 1 may be patentable even if Group 2 is not patentable. As such, it is unfair to group these claims together as they include limitations that do not stand or fall together.

With respect of **Paragraph (11), Response to Argument, First Issue**, the Appellants respectfully reiterate that The Cox and Konietzki patents cannot be properly combined to set forth a *prima facie* case of obviousness. The Cox patent relates to a patent for dispensing a foam string ('silly' string) of the type children may play with at parties. The Konietzki patent relates to hunting and unraveling a threaded string from a spool that applies hunting scents thereto. One having ordinary skill in the art contemplating problems with respect to dispensing a string for hunting would not logically avail themselves of the teachings of a 'silly' string dispenser used by children at parties. The Examiner line of reasoning in support thereof is flawed. The Examiner asserts that the mere mention of 'perfume' in the Cox patent is sufficient because it indicates that the perform may be used for hunting, even though there is no mention of the scent of the 'perform,' let alone that it is a hunting perfume. The


Examiner further notes that the mere fact that the Cox patent fails to mention hunting or anything related thereto does not preclude it from such uses. This may be true, however, the Appellants believe that it is improper for the Examiner to use the silence of the Cox patent as a basis for the rejection. Rather, it seems as though the Cox patent should provide some suggestion, motivation, or incentive to teach the claimed invention in order to be used against it. Moreover, the foam string of the Cox patent cannot be unraveled from the spool of the Konietzki patent, as the string of the Cox patent fails to include the necessary tensile strength - it is 'silly' string. The inability of the Cox and Konietzki patents to operate together further supports the lack of motivation to combine them. In short, there is no objective reason to combine these reference except for the reasons provided in the Appellant's application. The Examiner is engaging in improper hindsight reasoning and for this reason the Examiner has failed to properly set forth a *prima facie* case of obviousness.

With respect of **Paragraph (11), Response to Argument, Second Issue**, the Appellants respectfully submit that the Examiner is improperly asserting that the Cox patent recognizes the problem of preventing contamination of an area around a target. In particular, the Appellants respectfully submit that the Examiner is improperly construing the teachings of the Cox patent, as the Cox patent merely discloses that the pressure in the dispenser is sufficient to propel the 'silly' string a distance of six or more inches. The context of this disclosure is related to how far the foam is dispensed and not what is a safe distance from which to dispense the foam to a target for the purposes of preventing contamination of the target. With respect to defining the distance in which the hunter needs to be away from the target, the Appellants respectfully submit that such detail is not required. Such detail is not required to render the claim definite as one having ordinary skill in the art is enabled by the recited limitations. This issue is recognizing the problem of contaminating the area around the target and not the distance associated therewith.

S/N: 09/941,377  
Reply to Office Action of July 20, 2004

Atty Dkt No. ABF 0104 PUS

Respectfully submitted,  
**PATRICK JOSEPH CURRAN**

By   
John R. Buser  
Reg. No. 51,517  
Attorney/Agent for Applicant

Date: September 20, 2004

**BROOKS KUSHMAN P.C.**  
1000 Town Center, 22nd Floor  
Southfield, MI 48075-1238  
Phone: 248-358-4400  
Fax: 248-358-3351